UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,569	01/26/2001	Cynthia M. Merkin	16356.572 (DC-02618)	7616

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EXAMINER
CAO, CHUN

ART UNIT	PAPER NUMBER
2115	

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/770,569</td><td>Applicant(s)
MERKIN ET AL.</td></tr>
<tr><td>Examiner
Chun Cao</td><td>Art Unit
2115</td><td></td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2004*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

FINAL REJECTION

1.   Claims 1-30 are presented for examination.

2.   The text of those applicable section of Title 35, U.S. Code not included in this

action can be found in the prior Office Action.

3.   The rejection for claims 1-30 are respectfully maintained to the extended that is

applicable to the amended claims and reproduced hereinbelow for applicant's

convenience.

4.   Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell

et al. (Bell), US patent no. 5,875,293 in view of Schaefer (Schaefer), U.S. Patent No.

6,487,610.

Bell and Schaefer are the references cited in prior office action.

As per claim 1, Bell discloses a system [fig. 1] comprising:

a computer system [100, fig. 2A] under test having a plurality of ports [fig. 1; col.

2, lines 22-25, 59-67; col. 5, lines 9-22; "at least one available I/O port"] and including a

processor and a memory [col. 5, lines 45-64] and configured to boot using a system

firmware [col. 5, lines 32-35], the system firmware including instructions for causing the

computer system to:

a test apparatus coupled to transfer information to any port accessing the

processor of the computer system [col. 2, lines 28-32, 59-67; col. 5, lines 32-39]; and

initiate a manufacture mode of the system firmware [col. 5, lines 32-35].

Bell fails to detect a test apparatus coupled to the computer system, and initiate a manufacturing mode of the system firmware in response to detecting the test apparatus coupled to the computer system.

Schaefer teaches that a system firmware including instructions for causing the computer system to detect a test apparatus coupled to the computer system [col. 4, lines 4-11; col. 6, lines 49-61; col. 7, lines 39-41, 48-50], and initiating a manufacturing mode of the system firmware in response to detecting the test apparatus coupled to the computer system [col. 1, lines 62-63; col. 3, lines 45-66; col. 4, line 62-col. 5, line 6; col. 8, lines 1-6, 21-30].

It would have been obvious to one of ordinary skill in the art at time the invention to combine the teachings of Bell and Schaefer because they both teach a computer system for manufacturing testing, and the specific teaching of Schaefer states above would improve the efficiency of Bell's system by automatically initiating a manufacturing mode under test a computer system if a test apparatus is detected.

As per claim 2, Schaefer discloses that the system firmware includes instructions for causing the computer system to:

provide a first value to the test apparatus [col. 6, lines 49-51; col. 7, lines 39-41, 48-50]; receive a second value from the test apparatus in response to providing the first value to the test apparatus [col. 7, lines 61-64]; and initiate the manufacturing mode in response to receiving the second value from the test apparatus [col. 8, lines 1-30].

As to claims 3-6, Bell discloses the invention as claimed including perform an input/output operation and store the information provided onto the computer system [figs. 5, 6; col. 10, line 57-col. 11, line 7;col. 17, lines 42-49].

As per claim 7, Schaefer discloses that the system firmware includes instructions for causing the computer system to:

not initiate the manufacturing mode in response to not receiving the second value from the test apparatus [col. 7, lines 55-61].

As per claim 8, Bell discloses that the manufacturing mode of the system firmware includes instructions for causing the computer system to: receive information from the test apparatus; and store the information on a device in the computer system [col. 5, lines 27-29].

As per claim 9, Bell discloses that the manufacturing mode of the system firmware includes instructions for causing the computer system to: store the system firmware on a device in the computer system [col. 5, lines 27-29].

5.   As to claims 10-18, Bell and Schaefer together teach the claimed system. Therefore, Bell and Schaefer together teach the claimed computer program product for carrying out the system.

6.   As to claims 19-27, Bell and Schaefer together teach the claimed system. Therefore, Bell and Schaefer together teach the claimed method of steps for carrying out the system.

7.   As to claims 28-30 are written in means plus function format and contained same limitations as claims 1-3, therefore same rejection is applied.

8.   Applicant's arguments with respect to amended claims 1-30 have been
considered but are moot in view of the new ground(s) of rejection.

9.   Applicant's arguments filed on 9/10/2004 have been fully considered but are not
persuasive.

10.   In the remarks, applicant argued in substance that the cited references do not
teach or suggest a computer system under test having a plurality of ports and including
a processor and a memory and configured to boot using a system firmware, the system
firmware including instructions for causing the computer system to detect a test
apparatus coupled to transfer information to any port accessing the processor of the
computer system. Therefore, there is simply no basis in the art for combining the
references to support a 35 U.S.C. 103 rejection because neither Bell et al. patent nor
the Schaefer patent teaches or even suggests the desirability of the combination.
Moreover, neither patent provides any incentive or motivation supporting the desirability
of the combination.

11.   The examiner respectfully submits that applicant's position is not persuasive. Bell
discloses a computer system [100, fig. 2A] under test having a plurality of ports [fig. 1;
col. 2, lines 22-25, 59-67; col. 5, lines 9-22; "at least one available I/O port"] and
including a processor and a memory [col. 5, lines 45-64] and configured to boot using a
system firmware [col. 5, lines 32-35]; a test apparatus coupled to transfer information to
any port accessing the processor of the computer system [col. 2, lines 28-32, 59-67; col.
5, lines 32-39]. Schaefer teaches that a system firmware including instructions for
causing the computer system to detect a test apparatus coupled to the computer

system [col. 4, lines 4-11; col. 6, lines 49-61; col. 7, lines 39-41, 48-50], and initiating a

manufacturing mode of the system firmware in response to detecting the test apparatus

coupled to the computer system [col. 1, lines 62-63; col. 3, lines 45-66; col. 4, line 62-

col. 5, line 6; col. 8, lines 1-6, 21-30]. Also see detail rejection of claim 1 above.

In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bell fails to

detect a test apparatus coupled to the computer system, and initiate a manufacturing

mode of the system firmware in response to detecting the test apparatus coupled to the

computer system. However, Schaefer teaches that a system firmware including

instructions for causing the computer system to detect a test apparatus coupled to the

computer system [col. 4, lines 4-11; col. 6, lines 49-61; col. 7, lines 39-41, 48-50], and

initiating a manufacturing mode of the system firmware in response to detecting the test

apparatus coupled to the computer system [col. 1, lines 62-63; col. 3, lines 45-66; col. 4,

line 62-col. 5, line 6; col. 8, lines 1-6, 21-30]. It would have been obvious to one of

ordinary skill in the art at time the invention to combine the teachings of Bell and

Schaefer because they both teach a computer system for manufacturing testing, and

the specific teaching of Schaefer states above would improve the efficiency of Bell's

system by automatically initiating a manufacturing mode under test a computer system

if a test apparatus is detected.

12.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP ' 706.07(a). Applicant

is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE**

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Chun Cao whose telephone number is 571-272-3664.

The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Thomas C. Lee can be reached on 571-272-3667. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application should

be directed to the Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Chun Cao

Nov. 5, 2004